Ex parte Robinson etal

94-2225

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 46

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MELVIS I. ROBINSON
and
KENT B. ROBINSON

Appeal No. 94-2225
Application 07/766,916[1]

ON BRIEF

Before JERRY SMITH, BARRETT and FLEMING, *Administrative Patent Judges*.

FLEMING, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 8 and 10 through 15. Claim 9 has been canceled.

[1] Application for patent filed September 27, 1991. According to the appellants, the application is a continuation of Application 07/499,167, filed March 26, 1990, abandoned; which is a RE of Application 06/889,388, filed July 25, 1986, now Patent No. 4,734,697, granted March 29, 1988.

The invention is directed to an eye level, rear mounted light assembly for a motor vehicle tail light assembly. The light assembly provides brake lights, back-up lights, turn signals and a high beam deterrent light. The high beam deterrent light is a communication to the driver of a following vehicle that the headlights of the following vehicle are on high beam. The high beam deterrent light flashes a white low beam and a white high beam at the offender. In one embodiment, the high beam deterrent light is activated by a sensor that detects the high beam condition of the following vehicle. In another embodiment, the high beam deterrent light is manually activated by the driver of the vehicle.

Claim 1 is reproduced as follows:

1. A light assembly for rear mounted, eye level use with motor vehicles, comprising,

a housing means,

a plurality of light emitting devices mounted in said housing means,

lens cover means mounted at said housing means and comprising a plurality of sections having different colors whereby a selected color indication is produced when at least one of said plurality of light emitting devices is selectively activated,

said color indication having a recognized conventional safety characteristic to motorists,

said recognized conventional safety characteristic being primarily color-based, and

[reflector means disposed in said housing means adjacent to said light emitting devices for reflecting light from said light devices outwardly through said lens cover means,]

control means for selectively activating said plurality of light emitting devices,

said control means includes switch means for selectively activating at least one of said light emitting devices as a high beam indicator to signal the driver of a following motor vehicle that the headlights thereof are on high beam, said activation of said high beam indicator being operative to switch said light emitting devices between low brightness and high brightness conditions.

[sensor means mounted at said housing means and connected to said control means,

said sensor means operative to activate said switch when the headlights of a following motor vehicle are on high beam, and

indicator means passing through said housing means whereby activation of one of more of said light emitting devices can be detected from the back said housing means.]

The Examiner relies on the following references:

Ellison	3,501,742	Mar. 17, 1970
Lev	3,678,457	Jul. 18, 1972

Claims 1 through 8 and 10 through 15 stand rejected under 35 U.S.C. § 251. Claim 11 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention. Claims 1 through 6, 10, 12, 13 and 15 stand rejected under 35 U.S.C. § 103 as unpatentable over Ellison and Lev. The Examiner states on page

11 of the answer that claim 7, previously rejected as being unpatentable over Ellison and Lev under 35 U.S.C. § 103, is allowable over the art. The Examiner also states that claims 8 and 14 are also allowable over the art.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the briefs and answer for the respective details thereof.

OPINION

After a careful review of the evidence before us, we agree with the Examiner that claims 1 through 6, 10, 12, 13 and 15 are directed to subject matter that would have been obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103 as evidenced by Ellison and Lev. We also agree that claim 11 is properly rejected under 35 U.S.C. § 112, second paragraph. However, we do not agree that claims 1 through 8 and 10 through 15 are properly rejected under 35 U.S.C. § 251.

The Examiner states on page 4 of the answer that the declaration filed March 26, 1990 is insufficient because of "the failure of applicants to include the deleted functional language that follows the 'reflector means,' 'sensors means' and 'indicator means'." In reviewing the March 26, 1990 declaration, the Appellants refer to the deleted claim language as the above

mentioned means, but do not copy the entire claim language that is being deleted. For example, on page 5 of the March 26, 1990 declaration, Appellants state as follows:

> Claim 1 of Applicants' reissue application, as amended, is broader than Claim 1 of the Original Patent inasmuch as it excludes the previously, but unnecessary, claimed limitations of "reflector means", "sensor means" and "indicator means".

Appellants argue on page 2 of the reply brief that 35 U.S.C. § 251 "does not require the slavish copying of each work of an entire subparagraph that is being deleted".

We agree with the Appellants that 35 U.S.C. § 251 does not require the Appellants to repeat the entire amendment of the claims in the declaration. Upon review of the March 26, 1990 declaration, we find it is clear that the Appellants are referencing the claim language that is being deleted and that the reference includes the specific means as well as the corresponding functional language. Thus, we do not find the declaration is insufficient simply because it makes reference to "reflector means", "sensor means", and "indicator means" only and does not recite the functional language that follows these means.

The Examiner also argues that the supplemental declaration filed September 27, 1993 is insufficient because it does not copy all of the amended claim language but only makes

reference to such language. Again, we do not find the declaration is insufficient simply because it makes a clear reference to the amended language instead of providing a copy of the exact amendment language within the declaration. Therefore, we will not sustain the Examiner's rejection of claims 1 through 8 and 10 through 15 under 35 U.S.C. § 251.

The Examiner rejected claim 11 because the language, "said light emitting device", does not have an antecedent basis. On page 1 of the reply brief, Appellants state that they have filed a proposed amendment for claim 11, line 22, which changes "device" to --devices-- which overcomes the rejection under 35 U.S.C. § 112, second paragraph. However, in the letter dated January 5, 1994, the Examiner notified Appellants that this amendment is not entered. Appellants have not presented any arguments in any of the briefs that the rejection is not proper. In *In re Kroekel*, 803 F.2d 705, 231 USPQ 640 (Fed. Cir. 1986), the court held that arguments not made are waived. Accordingly, we will sustain the rejection of claim 11 under 35 U.S.C. § 112, second paragraph.

At the outset, we note that Appellants have indicated that claims 1 through 6 and 9 stand or fall together. We also note that only independent claims are argued. Since only the independent claims are argued and neither of the parties argues

separately the patentability of each of the rejected dependent claims, the dependent claims will stand or fall with independent claims. *In re Sernaker*, 702 F.2d 989, 991, 217 USPQ 1,3, (Fed. Cir. 1983). Thus, we will treat independent claims 1, 10 and 13 as representative claims for all the claims. *In re Nielson*, 816 F.2d 1567, 2 USPQ2d 1525 (Fed. Cir. 1987); *In re Kaslow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983); *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979).

Appellants argue that neither Ellison or Lev teaches a display device wherein a high beam condition is communicated by varying the brightness or intensity of a light emitting device between two active states. On page 6 of the brief, Appellants point to the language of independent claims 1, 10 and 13 that recite this limitation.

Ellison teaches in Figure 1 a rear mounted, eye level light assembly 20 for use with motor vehicles comprising a plurality of light emitting devices 100, 104, 106 and 102. Ellison further teaches in Figure 7 and in column 6, lines 21-34, an indicator being operative to switch light emitting devices 104 and 106 between dim and bright conditions. In particular, Ellison discloses that lamps 104 and 106 are double filament light sources. Ellison discloses that lamp 104 responds when

actuated by a condition (rapid braking) by switching on filament 108 and by flashing filament 112 on and off. Ellison similarly discloses that lamp 106 responds when actuated by a condition by switching on filament 110 and by flashing filament 114 on and off. Ellison further notes that filaments 112 and 114 emit about ten times as much light as emitted from filaments 108 and 110. Thus, Ellison teaches in Figure 7 an indicator being operative to switch light emitting devices 104 and 106 between dim and bright conditions as recited in Appellants' claims 1, 10 and 13.

Ellison does not teach that the indicator is a high beam indicator. However, the Examiner relies on Lev for the teaching to use an indicator as a high beam indicator. On page 9 of the answer, the Examiner states that "Lev discloses manually actuated signals for indicating the headlights of a following vehicle are on high beams, as shown by lamp 27e". In particular, Lev discloses in Figures 1 and 6 an indicator for a high beam indicator 51f. In column 5, lines 1-17, and Figure 11, Lev discloses that lamp 27e is the light source for the high beam indicator 51f and that a flasher may be used to flash the light source 27e to cause the indicator 51f to flash.

Thus, Lev teaches a high beam indicator that signals a high beam condition by being operative to switch the light

emitting device between a first state and a second state condition. Appellants argue that Lev teaches an on and off state and not a dim and bright state. However, as shown above, Ellison teaches an indicator operative to switch a lamp between dim and bright.

Appellants argue that there is no suggestion in the prior art to combine Ellison and Lev because the prior art did not suggest the desirability of the modification. Appellants argue on pages 7 and 8 of the brief that there is nothing in the cited prior art to disclose or suggest the desirability of communicating a message to the following vehicle by means of varying light intensity.

The question before us is whether one of ordinary skill in the art would have had reason to use the Ellison teachings of an indicator that switches the light emitting device between a dim and bright state as the Lev high beam indicator signal and to provide this modified high beam indicator in Ellison's rear mounted light assembly. The Federal Circuit stated that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), citing *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). However, from

these teachings in both Ellison and Lev, we find that the prior art would have suggested the desirability of providing an indicator that flashes between dim and bright and to mount this indicator in a rear eye level mounted assembly.

Ellison teaches in column 2, line 59, through column 3, line 5, that rear mounted assemblies positioned at eye level are more effective at communicating a message to a driver in a following vehicle because they are more visible than assemblies positioned at a lower level. Therefore, it would have been obvious to one of ordinary skill in the art to use the Ellison eye level mounting to position the Lev indicator at eye level because Ellison teaches that it is desirable to position rear signal lights at eye level to provide a more visible and thereby more effective warning.

Ellison also teaches that an indicator that flashes from a dim to a bright light is very effective to communicate a message rapidly. In column 8, lines 34-36, Ellison teaches that the emission of a bright flashing signal by flashing from dim to bright best warns following drivers of abrupt changes (sudden braking) which may require the following driver to take quick

action. In addition, Appellants have admitted in column 2, lines 6-9, of the original patent[2] that it is common practice to communicate to an offending driver who is operating his high beams by flashing white low and high beams at the offender. Thus, the prior art does suggest it is desirable to provide a warning signal that flashes to bright from dim because this warning is highly effective for alerting another driver. Therefore, we find that it would have been obvious to one of ordinary skill in the art to modify the Lev high beam indicator by using the Ellison indicator that operates to switch the light emitting devices between dim and bright conditions to obtain the Appellants' invention as recited in claims 1 through 6, 10, 12, 13 and 15.

In view of the foregoing, the decision of the Examiner rejecting claims 1 through 6, 10, 12, 13 and 15 under 35 U.S.C. § 103 is affirmed. In addition, the decision of the Examiner rejecting claim 11 under 35 U.S.C. § 112, second paragraph, is affirmed. However, the decision of the Examiner rejecting claims 1 through 8 and 10 through 15 under 35 U.S.C. § 251 is reversed.

[2]U. S. Patent 4,734,697 which is the basis of the reissue application before us on appeal.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a).

AFFIRMED-IN-PART

JERRY SMITH)
Administrative Patent Judge)
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LEE E. BARRETT)
Administrative Patent Judge) BOARD OF PATENT APPEALS AND INTERFERENCES
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